



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,968	08/04/2003	Yoshiyuki Sasaki	R2184.0258/P258	4462
24998	7590	07/10/2007		
DICKSTEIN SHAPIRO LLP 1825 EYE STREET NW Washington, DC 20006-5403			EXAMINER PATEL, GAUTAM	
			ART UNIT	PAPER NUMBER
			2627	
			MAIL DATE	DELIVERY MODE
			07/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/632,968	Applicant(s) SASAKI, YOSHIYUKI	
	Examiner Gautam R. Patel	Art Unit 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 12-17 and 22-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 12-17 and 22-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-8, 12-17, and 22-27 are pending for the examination.

RCE STATUS

2. The request filed on 5/4/07 for Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application is acceptable and a RCE has been established. An action on the RCE follows.

NOTES & REMARKS

3. The Examiner would like to thank Ms. Rachael Leventhal for explaining the "Remarks" [paper dated 5/4/07] and also for asking pertinent questions regarding where we stand.

Objection to Specification

4. The disclosure is objected for following reasons.
Specification needs to be updated with respect to information on the **related applications**. Cross-References to Related Applications: See 37 C.F.R. § 1.78 and section 201.11 of the M.P.E.P.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 2627

Claims 1-2, 12 and 22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 18 of copending application Serial No. 11/280,208. Although the conflicting claims are not identical, they are not patentably distinct from each other because one of ordinary skill in the art would have realized that eliminating a step or an element and its function are not patentable if the function of the step is not desired as shown in *Ex parte Wu*, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989). See also *In re Larson*, 340 F.2d 965, 144 USPQ 347 (CCPA 1965); and *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975). Although the conflicting claims are not identical, they are not patentably distinct from each other because the basic concept of background formatting and interrupting background formatting and resuming background formatting and revising control information has been claimed in claims 1-3 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

As to claims 2-8, 12-17 and 22-27 since they are also fully disclosed and claimed in the application number 11/280,208; they are therefore considered rejected as non-statutory double patenting as set forth in the paragraphs here in above.

Claim Rejections - 35 U.S.C. § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-8, 12-17, and 22-27 are rejected under 35 U.S.C. § 102(b) as being anticipated by Sasaki, E. P. application patent EP 1 282 128 A1 (hereafter Sasaki).

As to claim 1, Sasaki discloses the invention as claimed [see Figs. 1-9] including a first step of outputting and a second step of starting the initialization, comprising the steps of:

a first step of outputting termination information indicative of termination of the initialization of an information recording medium before said initialization starts; and

a second step of starting the initialization at a predetermined timing after the output of the termination information [paragraphs 19-73].

7. The aforementioned claim 2, recites the following steps, inter alia, disclosed in Sasaki:
the initialization comprises a formatting process and the predetermined timing is a receipt time of a format interrupt request of the information recording medium [paragraphs 19-73].

8. The aforementioned claim 3, recites the following steps, inter alia, disclosed in Sasaki:
the predetermined timing is a receipt time of an ejection request of the information recording medium [paragraphs 19-73].

9. The aforementioned claim 4, recites the following steps, inter alia, disclosed in Sasaki:
the predetermined timing is a time at which access to the information recording medium is not requested [paragraphs 19-73].

10. The aforementioned claim 5, recites the following steps, inter alia, disclosed in Sasaki:
a third step of creating, in response to an initialization information request for requesting information regarding the initialization before completion of the initialization, provisional information corresponding to the information regarding the initialization and providing the provisional information in response to the initialization information request [paragraphs 19-73].

11. The aforementioned claim 6, recites the following steps, inter alia, disclosed in Sasaki:
a fourth step of interrupting the initialization in response to a write request for recording user data in the information recording medium; and a fifth step of restarting the initialization after the user data have been recorded in the information recording medium [paragraphs 19-73].

12. The aforementioned claim 7, recites the following steps, inter alia, disclosed in Sasaki:
the second step records predetermined management information in a lead-in area of the information recording medium [paragraphs 31-43, & 68-78].

13. The aforementioned claim 8, recites the following steps, inter alia, disclosed in Sasaki:
information recording medium complies with a DVD+RW standard [paragraph 73].

14. The aforementioned claim 12, recites the following elements, inter alia, disclosed in Sasaki:

a termination information output part [fig. 1, unit 9], in response to an initialization request for initializing the information recording medium, outputting termination information indicative of termination of the initialization before said initialization starts; and

an initialization part [fig. 1, unit 9] starting the initialization by recording predetermined initialization information in a predetermined area in the information recording medium at a predetermined timing after the output of the termination information [paragraphs 19-73].

15. The aforementioned claim 13, recites the following steps, inter alia, disclosed in Sasaki:
the initialization request is issued by an external apparatus [paragraphs 19-73].

16. The aforementioned claim 14, recites the following steps, inter alia, disclosed in Sasaki:
a response part, in response to the initialization information request before completion of the initialization, creating provisional information corresponding to the initialization information and providing the provisional information in response to the initialization information request [paragraphs 19-73].

17. The aforementioned claim 15, recites the following steps, inter alia, disclosed in Sasaki:
the initialization information request is issued by an external apparatus [paragraphs 19-73].

18. The aforementioned claim 16, recites the following steps, inter alia, disclosed in Sasaki:
an initialization interruption part interrupting the initialization in response to a write request for recording user data in the information recording medium; and
an initialization restart part restarting the initialization after the user data have been recorded in the information recording medium [paragraphs 19-73].

19. The aforementioned claim 17, recites the following steps, inter alia, disclosed in Sasaki:
the write request is issued by an external apparatus [paragraphs 19-73].

20. As to claims 22-27, they are method claims corresponding to claims 1-6 respectively and they are therefore rejected for the similar reasons set forth in the rejection of claims 1-6 respectively, above.

NOTE: Storing program on disc and executing steps is well known and does not constitute patentable differentiation as such. Also limitation in the preamble does not breath life into the body of the claim.

ALTERNATE REJECTION-1

Claim Rejections - 35 U.S.C. § 102

21. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-2, 4-6, 8, 12-17, and 22-23, 25-27 are rejected under 35 U.S.C. § 102(a) as being anticipated by Sasaki, European Patent Application EP 1 229 534 A2 (hereafter Sasaki-534).

As to claim 1, Sasaki discloses the invention as claimed [see Figs. 1-9] including a first step of outputting and a second step of starting the initialization, comprising the steps of:

a first step of outputting termination information indicative of termination of the initialization of an information recording medium before said initialization starts; and

a second step of starting the initialization at a predetermined timing after the output of the termination information [paragraphs 36-62].

Art Unit: 2627

22. The aforementioned claim 2, recites the following steps, inter alia, disclosed in Sasaki-534:

the initialization comprises a formatting process and the predetermined timing is a receipt time of a format interrupt request of the information recording medium [paragraphs 36-62].

23. The aforementioned claim 4, recites the following steps, inter alia, disclosed in Sasaki-534:

the predetermined timing is a time at which access to the information recording medium is not requested [paragraphs 36-62].

24. The aforementioned claim 5, recites the following steps, inter alia, disclosed in Sasaki-534:

a third step of creating, in response to an initialization information request for requesting information regarding the initialization before completion of the initialization, provisional information corresponding to the information regarding the initialization and providing the provisional information in response to the initialization information request [paragraphs 36-62].

25. The aforementioned claim 6, recites the following steps, inter alia, disclosed in Sasaki-534:

a fourth step of interrupting the initialization in response to a write request for recording user data in the information recording medium; and a fifth step of restarting the initialization after the user data have been recorded in the information recording medium [paragraphs 36-62].

26. The aforementioned claim 8, recites the following steps, inter alia, disclosed in Sasaki-534:

information recording medium complies with a DVD+RW standard [paragraph 39].

27. The aforementioned claim 12, recites the following elements, inter alia, disclosed in Sasaki-534:

a termination information output part [fig. 1, unit 13], in response to an initialization request for initializing the information recording medium, outputting termination information indicative of termination of the initialization before said initialization starts; and

an initialization part [fig. 1, unit 13] starting the initialization by recording predetermined initialization information in a predetermined area in the information recording medium at a predetermined timing after the output of the termination information [paragraphs 36-62].

28. The aforementioned claim 13, recites the following steps, inter alia, disclosed in Sasaki-534:

the initialization request is issued by an external apparatus [paragraphs 36-62].

29. The aforementioned claim 14, recites the following steps, inter alia, disclosed in Sasaki-534:

a response part, in response to the initialization information request before completion of the initialization, creating provisional information corresponding to the initialization information and providing the provisional information in response to the initialization information request [paragraphs 36-62].

30. The aforementioned claim 15, recites the following steps, inter alia, disclosed in Sasaki-534:

the initialization information request is issued by an external apparatus [paragraphs 36-62].

31. The aforementioned claim 16, recites the following steps, inter alia, disclosed in Sasaki-534:

an initialization interruption part interrupting the initialization in response to a write request for recording user data in the information recording medium; and

an initialization restart part restarting the initialization after the user data have been recorded in the information recording medium [paragraphs 36-62].

Art Unit: 2627

32. The aforementioned claim 17, recites the following steps, inter alia, disclosed in Sasaki-534:

the write request is issued by an external apparatus [paragraphs 36-62].

33. As to claims 22-27, they are method claims corresponding to claims 1-6 respectively and they are therefore rejected for the similar reasons set forth in the rejection of claims 1-6 respectively, above.

NOTE: Storing program on disc and executing steps is well known and does not constitute patentable differentiation as such. Also limitation in the preamble does not breath life into the body of the claim.

Claim Rejections - 35 U.S.C. § 103

34. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sasaki-534 as applied to claims 1, 12 and 22 above in view of Hashimoto, European Patent Application EP 0 899 735 A2 (hereafter Hashimoto).

As to claim 3, Sasaki-534 discloses all of the above elements, including first second steps of formatting as claimed . Sasaki does not specifically disclose predetermine timing is a receipt time of an ejection request.

However, it is well known in the art that most system does require timing for ejection so as not to eject disc at wrong tome such as in the middle of the writing or reading. Also more importantly Hashimoto clearly discloses:

the predetermined timing is a receipt time of an ejection request of the information recording medium [fig. 9, paragraphs 89-93].

Art Unit: 2627

Both Sasaki-534 and Hashimoto are interested in improving the formatting process taking place in the background representing analogous art.

One of ordinary skill in the art at the time of invention would have realized that the system of Sasaki-534 would have been vulnerable if system gives ejection command when formatting is being performed.

Therefore, it would have been obvious to have used a timing signal during formatting to prevent wrong ejection in the system of Sasaki-534 as taught by Hashimoto because one would be motivated to prevent wrong ejection in the system of Sasaki-534 and faster formatting and undue delays due to wrong ejections [paragraph 89; Hashimoto].

35. As to claim 24, it is rejected for the similar reasons set forth in the rejection of claim 3, above.

36. Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Sasaki-534 as applied to claims 1, 12 and 22 above in view of Hashimoto, European Patent Application EP 0 899 735 A2 (hereafter Hashimoto).

As to claim 7, Sasaki-534 discloses all of the above elements, including first second steps of formatting as claimed . Sasaki does not specifically disclose that second step records predetermined management information in a lead-in area of the medium to the extent claimed.

However, it is well known in the art to record management information in lead-in area and it inherently done in most system for managing each individual area better thus saving time of operation of the system. Also more importantly Sims clearly discloses:

the second step records predetermined management information in a lead-in area of the information recording medium [col. 8, lines 5-41; figs. 4 & 7].

Both Sasaki-534 and Sims are interested in improving the formatting process taking place in the background representing analogous art.

Art Unit: 2627

One of ordinary skill in the art at the time of invention would have realized that the system of Sasaki-534 could be made faster by providing management information in front of each section in the form of a lead-in area.

Therefore, it would have been obvious to have used storage of management information in lead-in area in the system of Sasaki-534 as taught by Sims because one would be motivated to make system faster and more manageable thus saving time and money by reducing time in incremental data recording thus achieving fast initial usability [col. 8, lines 13-42; Sims].

ALTERNATE REJECTION-2

Claim Rejections - 35 U.S.C. § 102

37. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 12-17, and 22-27 are rejected under 35 U.S.C. § 102(b) as being anticipated by Itaru, Japanese patent document no. 04178965 (hereafter Itaru).

As to claims 1-8 and 12-17 Itaru discloses the invention as claimed [see Figs. 1] including a first step, and second step comprising steps of :

a first step of outputting termination information indicative of termination of the initialization of an information recording medium before said initialization starts; and

a second step of starting the initialization at a predetermined timing after the output of the termination information [pages 7-12; fig. 1].

38. as to claim 7 concept of putting management information in lead-in area is well known and inherently done in most of the systems and is not a patentable differentiation.

39. As to limitations claims 2-7 and 12-17 they are also described in pages 7-12.

Art Unit: 2627

40. As to claims 22-27, they are method claims corresponding to claims 1-6 respectively and they are therefore rejected for the similar reasons set forth in the rejection of claims 1-6 respectively, above.

NOTE: Storing program on disc and executing steps is well known and does not constitute patentable differentiation as such. Also limitation in the preamble does not breath life into the body of the claim.

Claim Rejections - 35 U.S.C. § 103

41. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Itaru as applied to claims 1-7 above.

Itaru teaches all of the above elements and that his steps are applicable to CD disc. Hashimoto does not specifically teach that his steps of interrupting formatting and restarting is equally applicable to a DVD+RW disc. "Official Notice" is taken that both the concept and the advantages of providing interrupt logic are well known and expected in the art. It would have been obvious to included these steps to a DVD+RW disc as this disc are known to provide larger storage capacity and thereby saving time and money on storing programs such as video data. These concepts are well known in the art and do not constitute a patentably distinct limitation, per se [M.P.E.P. 2144.03].

42. Applicant's arguments with respect to above claims have been carefully considered but are moot in view of the new grounds of rejection.

Art Unit: 2627

Contact information

43. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gautam R. Patel whose telephone number is 571-272-7625. The examiner can normally be reached on Monday through Thursday from 7:30 to 6.

The appropriate fax number for the organization (Group 2600) where this application or proceeding is assigned is 571-273-8300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Dwayne Bost, who can be reached on (571) 272-7023.

Any inquiry of a general nature or relating to the status of this application should be directed to the Electronic Business Center whose telephone number is 866-217-9197 or the USPTO contact Center telephone number is (800) PTO-9199.



**GAUTAM R. PATEL
PRIMARY PATENT EXAMINER**

Gautam R. Patel
Primary Examiner
Group Art Unit 2627

June 27, 2007